

**REMARKS**

At the time of the Office Action dated April 25, 2006, claims 8-15 were pending and rejected in this application. Claims 8-10 have been amended, and claim 15 has been cancelled. Care has been exercised to avoid the introduction of new matter. Specifically, claims 8-10 have been amended to clarify the limitations recited therein. Applicants submit that the present Amendment does not generate any new matter issue.

With regard to the Examiner's objection to claim 15 on page 7 of the Office Action, Applicants note that claim 15 has been cancelled.

**CLAIMS 8, 10, 12, AND 14 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35**

**U.S.C. § 112**

On pages 3 and 4 of the Office Action, the Examiner separately asserted that claims 8, 10, 12, and 14 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

At the outset, Applicants note that the Examiner has improperly relied upon the case law found in M.P.E.P. § 2172.01, which for ease of reference is reproduced below:

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). >But see *Ex parte*

*Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965) ("[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result"); *Ex parte Huber*, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes).<

At the outset, Applicants note that the case law referred to above generally applies to "kit" or "assembly" claims. The claims at issue, however, are directed to a method, which on their face does not appear to be kit or assembly claims.

Moreover, as summarized in above-reproduced passages, the case law requires that the alleged omitted essential matter be identified by Applicants as "essential" within the "specification" or within "other statements of record." The Examiner, however, has failed to establish that the features alleged by the Examiner to be omitted, have been identified, by Applicants, as being essential.

Applicants surmise that the Examiner has misinterpreted the enablement requirement of the first paragraph of 35 U.S.C. § 112, since the Examiner appears to be requiring that the independent claims enable the invention. This requirement, however, is not consonant with the first paragraph of 35 U.S.C. § 112, which requires only that the specification describe how to make and use the invention.

Notwithstanding the Examiner improperly relying on M.P.E.P. § 2172.01, Applicants note that claims 8 and 10 have been amended. Specifically, Applicants have clarified that the claimed "the publication" refers to the claimed "receiving a publication message" by amending the "the publication" to read "the publication message." Applicants have also clarified the language in claim 8 regarding the "attribute" by reciting "mapping at least part of the at least one

attribute to a generic format." Moreover, Applicants have clarified the limitations recited in claim 8 by deleting the first recitation of "generic format filter attribute."

As to the ninth enumerated paragraph of the Office Action, the Examiner asserted that "therefore there is no determination of what is appropriate for a subscriber being made in the claim." As noted earlier, claims are only required to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, not enable the claimed invention. Applicants have determined that how the determination is made is not required to particularly point out and distinctly claim, within claim 1, the subject matter which Applicants regard as the invention.

With regard to the eleventh enumerated paragraph of the Office Action, the Examiner is again trying to improperly require that the claims enable the invention. With regard to the limitations recited in claim 10, the Examiner is directed to the last full paragraph on page 20 and the first full paragraph on page 21.

With regard to the thirteenth enumerated paragraph, claim 14 depends upon claim 8, which recites "a format corresponding to the second message type," and thus, proper antecedent basis exists for the limitation "said format."

Thus, the imposed rejections of claims 8, 10, 12, and 14 under the second paragraph of 35 U.S.C. § 112 have been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

**CLAIMS 8-15 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON HERZ**

On pages 5-7 of the Office Action, the Examiner asserted that Herz discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

On page 2 of the Office Action, the Examiner asserted that "[t]he rejection based on Herz has been written to more clearly pointing [sic] out all specific elements." Upon reviewing the Examiner's latest rejection of the claims based upon Herz, Applicants respectfully disagree since the present rejection based upon Herz suffers from the same problems present in the Examiner's prior rejection based upon Herz. Specifically, the statement of the rejection fails to clearly identify many of the specific elements within Herz being relied upon in the rejection as required by 37 C.F.R. § 1.104(c).<sup>1</sup>

**Claim 8**

For example, independent claim 8, as originally presented, recites "receiving a subscription request of a first type, said request including a filter expression having at least one attribute," and in the statement of the rejection regarding this limitation, the Examiner cited column 4, line 49 through column 5, line 7 of Herz and asserted "the search profile or query contains keywords and target objects to request publications of interest." For ease of reference, column 4, line 49 through column 5, line 7 of Herz is reproduced below:

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<sup>1</sup> 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Relevant definitions of terms for the purpose of this description include: (a.) an object available for access by the user, which may be either physical or electronic in nature, is termed a "target object", (b.) a digitally represented profile indicating that target object's attributes is termed a "target profile", (c.) the user looking for the target object is termed a "user", (d.) a profile holding that user's attributes, including age/zip code/etc. is termed a "user profile", (e.) a summary of digital profiles of target objects that a user likes and/or dislikes, is termed the "target profile interest summary" of that user, (f) a profile consisting of a collection of attributes, such that a user likes target objects whose profiles are similar to this collection, of attributes, is termed a "search profile" or in some contexts a "query" or "query profile," (g.) a specific embodiment of the target profile interest summary which comprises a set of search profiles is termed the "search profile set" of a user, (h.) a collection of target objects with similar profiles, is termed a "cluster," (i.) an aggregate profile formed by averaging the attributes of all target objects in a cluster, termed a "cluster profile," (j.) a real number determined by calculating the statistical variance of the profiles of all target objects in a cluster, is termed a "cluster variance," (k.) a real number determined by calculating the maximum distance between the profiles of any two target objects in a cluster, is termed a "cluster diameter."

This passage cited by the Examiner does not teach anything with regard to receiving a subscription request of a first type, as recited in claim 8. Instead, the passage cited by the Examiner is just a collection of terms that the Herz has deemed to define.

Regarding the Examiner's specific assertion that "the search profile or query contains keywords and target objects to request publications of interest," although Applicants note that in definition (f), Herz teaches "a profile consisting of a collection of attributes, such that a user likes target objects whose profiles are similar to this collection, of attributes, is termed a 'search profile' or in some contexts a 'query' or 'query profile,'" Herz fails to teach that keywords and target objects are found in a subscription request, as recited in claim 8. Thus, there is no apparent teaching within this passage that a subscription request includes a first expression having at least one attribute, as recited in claim 8.

Moreover, Applicants are unable to determine where, within this passage, Herz teaches the claimed receiving a subscription request of a first type. This passage within Herz is silent as to a subscription request, and thus, is also silent as to a "first type" of a subscription request.

Therefore, the Examiner has failed to establish that Herz identically discloses the above-reproduced claimed invention within the meaning of 35 U.S.C. § 102.

As another example, independent claim 8, as amended, recites "mapping at least part of the at least one attribute to a generic format," and in the statement of the rejection regarding this limitation, the Examiner cited column 57, lines 39-51, which for ease of reference is reproduced below:

Rather than carry out steps 5-9 of the above process separately for each search profile of each user, it is possible to achieve added efficiency by carrying out these steps only once for each group of similar search profiles, thereby satisfying many users' needs at once. In this variation, the system begins by non-hierarchically clustering all the search profiles in the search profile sets of a large number of users. For each cluster  $k$  of search profiles, with cluster profile  $p_k$ , it uses the method described in the section "Searching for Target Objects" to locate articles with target profiles similar to  $p_k$ . Each located article is then identified as of interest to each user who has a search profile represented in cluster  $k$  of search profiles.

Upon reviewing this passage, Applicants are unclear as to where, within this passage, Herz teaches mapping at least part of the at least one attribute to a generic format. Specifically, Applicants are unable to determine what feature within Herz identically discloses the claimed (i) generic format; (ii) the at least one attribute; and (iii) the mapping.

As yet another example, independent claim 8, as originally presented, recites "receiving a publication message of a second type," and in the statement of the rejection regarding this limitation, the Examiner again cited column 4, line 49 through column 5, line 7 of Herz and asserted "the target profile." Upon reviewing this cited passage, which has already been reproduced above, Applicants are unclear as to how the teaching of "the target profile" identically discloses the claimed "receiving a publication message of a second type." Definition (b) of Herz states that "a digitally represented profile indicating that target object's attributes is

termed a 'target profile'," which is silent as to both a "second type" and "receiving a publication message."

Independent claim 8, as amended, further recites "comparing the publication message received to the subscription request to determine whether the publication message is appropriate for forwarding onto the subscriber originating the request," and in the statement of the rejection regarding this limitation, the Examiner cited column 57, lines 8-36 and asserted "the search profile is compared with the target profile." In this regard, Applicants incorporate herein the arguments previously presented in the Pre-Appeal Brief Request for Review dated November 23, 2005. Specifically, reference is made to arguments entitled, "Examiner confusing 'specifying search parameters' with 'subscription request'," which are found in the paragraph spanning pages 3 and 4 and the first full paragraph on page 4. Applicants' arguments, however, were not addressed by the Examiner in the present rejection. In this regard, the Examiner is referred to M.P.E.P. § 707.07(f), which states that "the Examiner, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

Independent claim 8, as originally presented, also recites "identifying a generic format filter attribute," and in the statement of the rejection regarding this limitation, the Examiner cited columns 57 and 58 and asserted "the target profile." Applicants note, however, that the Examiner also asserted that the claimed "receiving a publication message of a second type" is also disclosed by "the target profile." In this regard, Applicants are unclear as to how the Examiner can assert that the same taught feature (i.e., the target profile) can teach both

"identifying a generic format filter attribute" and "receiving a publication message of a second type," as recited in claim 8.

Claim 10

Dependent claim 10 recites:

creating a substantially empty message of said first type;  
extracting information from the publication message of said second type; and  
inputting said information into said substantially empty message.

On page 3 of the Office Action, the Examiner only asserted "the search profiles can contain few keywords or target objects" and "attributes are examined from the target profiles." Based upon these assertions, Applicants are unclear as to why the Examiner believes the above-reproduced limitations recited in claim 10 are identically disclosed by Herz since the Examiner's comments and the claimed limitations appear to be completely different.

Claims 11-14

With regard to these limitations, the Examiner merely cites column 56, line 49 through column 57, line 5 or asserts "the [target/search] profiles are analyzed as described above." This "analysis" by the Examiner again fails to clearly identify the specific elements within Herz being relied upon in the rejection.

Therefore, for the reasons stated above, Applicants submit that the imposed rejection of claims 8-14 under 35 U.S.C. § 102 for anticipation based upon Herz is not factually viable. Thus, Applicants respectfully solicit withdrawal of the imposed rejection of claims 8-14 under 35 U.S.C. § 102 for anticipation based upon Herz.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 25, 2006

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